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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/490,476	01/24/2000	David Whitaker	P0435OUSO-PHI-1196	7190

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EXAMINER	
MEHTA, ASHWIN D	
ART UNIT	PAPER NUMBER
1638	7

DATE MAILED: 12/18/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/490,476	WHITAKER, DAVID	
	Examiner	Art Unit	
	Ashwin Mehta	1638	

-- Th MAILING DATE of this communication app ars on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133)
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-32 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-32 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

The text of those sections of Title 35, U.S. Code, not found in this action can be found in a prior action.

Specification

1. The objection to the specification is maintained, for the reasons of record stated in the last Office action. Applicant's intent, indicated in the paper submitted 09 October 2001 (page 8, second paragraph), to deposit the claimed seed and amend the specification upon indication of allowability of the claims is acknowledged.

Claim Objections and Rejections

2. Claims 1, 5 (amended), and 7 (amended) remain objected to for the reasons of record stated in the last Office action. Applicant's intent, indicated in the paper submitted 09 October 2001 (page 8, third paragraph), to deposit the claimed seed and amend the claims upon indication of allowability of the claims is acknowledged.

3. Claims 1-4, 5-7 (all amended), 9-11 (all amended), 12, and 13-14 (both amended) remain rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of U.S. Patent No. 6,075,187, for the reasons of record stated in the last Office action.

4. Claims 1-4, 5-11 (all amended), 12, 13-15 (all amended), 16, 17-19 (all amended), 20, 21-24 (all amended), 25, 26-28 (all amended), 29, and 30-32 (all amended) remain rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention, for the reasons of record stated in the last Office action, on page 4, top paragraph.

5. Claims 1-4, 5-11 (all amended), 12, 13-15 (all amended), 16, 17-19 (all amended), 20, 21-24 (all amended), 25, 26-28 (all amended), 29, and 30-32 (all amended) remain rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention, for the reasons of record stated in the last Office action.

6. Claims 1-4, 5-11 (all amended), 12, 13-15 (all amended), 16, 17-19 (all amended), 20, 21-24 (all amended), 25, 26-28 (all amended), 29, and 30-32 (all amended) remain rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Stucker (U.S. Patent No. 6,075,187), for the reasons of record stated in the last Office action.

Response to Arguments

7. Applicant's arguments filed 09 October 2001 have been fully considered but they are not persuasive.

35 USC § 112

8. Applicants traverse the rejection to claims 1-4, 5-7 (all amended), 9-11 (all amended), 12, and 13-14 (both amended) under the judicially created doctrine of obviousness-type double patenting. Applicants indicate that the actual ATCC deposit will be delayed until receipt of notice that the application is otherwise allowable (response, paragraph bridging pages 8 and9). Applicant's intent is acknowledged. As the application is not in condition for allowance, the rejection is maintained.

9. Applicants traverse the rejection to claims 1-4, 5-11 (all amended), 12, 13-15 (all amended), 16, 17-19 (all amended), 20, 21-24 (all amended), 25, 26-28 (all amended), 29, and 30-32 (all amended) under 35 U.S.C. 112, second paragraph. Applicants submit that a deposit will be delayed until a notice of allowable claims is provided. Applicants indicate that the claims will be amended at that time to recite the accession number (response, page 9, second full paragraph). As the application is not in condition for allowance, the rejection is maintained.

10. Applicants traverse the rejection to claims 1-4, 5-11 (all amended), 12, 13-15 (all amended), 16, 17-19 (all amended), 20, 21-24 (all amended), 25, 26-28 (all amended), 29, and 30-32 (all amended) under 35 U.S.C. 112, first paragraph. Applicants indicate that the actual ATCC deposit will be delayed until receipt of notice that the application is otherwise allowable. Applicant's intent is acknowledged. As the application is not in condition for allowance, the rejection is maintained.

35 USC § 102 & 103

11. Applicants traverse the rejection to clams 1-4, 5-11 (all amended), 12, 13-15 (all amended), 16, 17-19 (all amended), 20, 21-24 (all amended), 25, 26-28 (all amended), 29, and 30-32 (all amended) under 35 U.S.C. 102(e) as anticipated by, or in the alternative, under 35 U.S.C. 103(a) as obvious under Stucker. Concerning claims 1-10, 12-14, 16-18, 20-23, 25-27, and 29-31: Applicants argue that the deposit will be made and claims will be amended with the ATCC accession number upon indication of allowable subject matter. Regarding claims 11, 15, 19, 24, 28, and 32: Applicants argue that to say there are similarities in phenotype between two varieties is not the same as saying that the two varieties had the same morphological and physiological characteristics as a whole, or the one is an obvious variant of the other (response, page 12, second full paragraph). Applicants submit that the claims do not simply recite traits, but instead recite specific traits only to the extent that they are "34G13" traits, and that the claims also recite that the plant must have 34G13 as an ancestor, and contend that the traits therefore originated from 34G13(response, page 12, third full paragraph).

Regarding claims 1-10, 12-14, 16-18, 20-23, 25-27, and 29-31: Applicant's intent to deposit seed and amend the claims is acknowledged. The rejection is maintained, as all of the claims are not yet in condition for allowance. Regarding Applicants' traverse of claims 11, 15, 19, 24, 28, and 32: The claims indicate that the plants need to have 2 of the indicated traits, not all of the traits of 34G13. Further, the traits listed in the claims are not unique to 34G13. Other plants may possess any one or more than one of these traits. The claims do not indicate what feature of any one of these traits makes it unique only to 34G13. Further, the claims do not distinguish plants that possess at least two of the listed traits that do not have 34G13 in its

ancestry from those that do. Applicants also argue that undue experimentation would be required to begin with the hybrid of 34G13, and breed it to recover a hybrid with at least two of the traits enumerated in the claims, and that there is no expectation of success (paragraph bridging pages 12 and 13). Applicants also assert that hindsight reconstruction was used (page 13, first full paragraph). However, as discussed in the last Office action, Stucker does teach a plant with at least two of the indicated characteristics. The process of making the claimed plants does not distinguish the plants themselves from those taught by the reference, particularly since neither the number of other parents nor the number of generations involved in producing the plants are specified, wherein 34G13-derived genetic material is lost as the number of other parents or generations increases. See In re Thorpe, 227 USPQ 964,966 (Fed. Cir. 1985), which teaches that a product-by-process claim may be properly rejectable over prior art teaching the same product produced by a different process, if the process of making the product fails to distinguish the two products. Further, hindsight reconstruction was not used, as only one reference teaches the invention. Construction of the claimed invention from multiple references was not conducted. Thus, the claimed invention was clearly prima facie obvious as a whole to one of ordinary skill in the art, if not anticipated by Stucker. The rejection is maintained.

12. No claim is allowed.

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Contact Information

Any inquiry concerning this or earlier communications from the examiner should be directed to Ashwin Mehta whose telephone number is 703-306-4540. The examiner can normally be reached from 8:00 A.M to 5:30 P.M. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paula Hutzell, can be reached at 703-308-4310. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3014 for regular communications and 703-872-9307 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

A.M.
December 12, 2001

DAVID T. FOX
PRIMARY EXAMINER
GROUP ~~180~~ 1638